

NEC01P072-TSe
Response dated 03/05/2004

AFTER FINAL: EXPEDITED ACTION

01480072aa
Reply to office action mailed 12/31/2003

REMARKS

Claims 1-59 are currently pending in the application, with claims 23-32 and 34-59 having been provisionally withdrawn from consideration in response to a restriction requirement and election. The foregoing separate sheets marked as "Listing of Claims" shows all the claims in the application, with an indication of the current status of each .

The Examiner's acceptance of the drawings filed on October 22, 2003 is acknowledged with appreciation.

The Examiner has objected to the disclosure for failure to identify "the means for limiting further use of the trial purchase system." The means is shown by the decision box S18 in Figure 3, where the selling system 3 determines whether the user wishing to make a trial purchase (as shown in item S16 in Figure 2) has already performed a trial purchase. To make this determination, the selling system 3 consults the customer information database 5. It will be observed from S17 in Figure 3 that this determination is made for members, who must log in and provide a user ID as described in Figure 4. If the user is not a member (at item S29 in Figure 4), customer information is obtained as described in Figure 5 and an ID and password are issued (see item S39 in Figure 5). With the ID and password, the new user returns to the process at item S30 in Figure 4, where the ID and password are verified by the selling system 3 at item S32 in Figure 4, whereupon the new user is returned to decision box S18 in Figure 3. Consequently, the new user will proceed to item S20 in Figure 3 and complete the order at item S27, including delivery instructions at item S26, without having to make payment (page 13, lines 25-26). By contrast, if a trial purchase has already been made, as recorded in customer information database 5, then the user will be advised that at item S19 on Figure 3 that a trial purchase cannot be provided. It should be noted that the trial purchase service may be provided more than once, so

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that the user would be denied further trial purchases at item S19 if an allowed number of trial purchases greater than one have already been made (see page 13, lines 1-2).

The means for limiting further use of the trial purchase system having thus been demonstrated from the specification and drawings, it is submitted that the Examiner's objection to the disclosure is thereby overcome.

The present invention is intended to overcome initial hesitance of a customer to use a web page for making purchases, by using the web page to distribute selected products for free (see page 13, line 26) or for a reduced charge and for limited quantities (see page 9, lines 1-4). The problem being addressed by the present invention is the contrast between the in-store purchase experience familiar to the user and the online experience (page 3, lines 10-13). The trial purchase commodity may be provided for pickup at the designated destination (page 4, line 17). The invention provides mechanisms to overcome first time customer hesitancy to engage in online purchase for reasons such as fear of paying for a commodity and not receiving it (page 3, lines 17-18) or not knowing whether or how or at what cost a commodity can be changed (page 3, lines 20-24). Since the invention is directed to new customers, provision is made in the invention for limiting the trial purchase opportunity to those who have not already performed a trial purchase (see step S18 in Figure 3), although a merchant may provide the trial purchase service more than once to the same customer (page 13, lines 1-2).

The Examiner has rejected claims 1, 2, 5 and 6 under 35 U.S.C. §103(a) as being unpatentable over the Equinox web page. The Examiner has acknowledged that the Equinox web page fails to include the additional step of limiting further use of the purchase procedure by users who have had prior experience with the purchase procedure. This step is implemented in one embodiment as described above in response to the Examiner's objection to the specification. The Examiner argues that this step "can be easily performed as the step relates to the user's desire to further use the company's commodities." The Examiner states that "the user can limit" further

use of the purchase procedure. However, as is evident from the above description of how the invention limits further use of the trial purchase system, it is not the user but the selling system that determines whether a particular user has exceeded limitations on use of the trial purchase system.

Furthermore, the participial phrase used in the claims

“limiting further use of said purchase procedure by users who have had prior experience with said purchase procedure”

has a clear and unambiguous interpretation in accordance with the rules of English grammar. The term “by users” modifies “use”. Similarly, “of said purchase procedure” also modifies “use”. The Examiner’s suggestion that “by users” qualifies the participle “limiting” is grammatically inconsistent with the language as written. One would have to add the clause “wherein said limiting step can be executed by the users” in order to justify the interpretation advanced by the Examiner. No such additional clause is part of the claim. Consequently, it is incorrect to assert that the claim language as written can be interpreted to mean that “limiting” can be done “by users.” The Examiner’s argument depends entirely upon this incorrect premise.

Therefore, since the Examiner has acknowledged that the Equinox web page fails to include the foregoing limiting step, this reference has been overcome as to claims 1 and those claims dependent from claim 1.

The Examiner has also rejected claims 1-22 and 33 under 35 U.S.C. §103(a) as being unpatentable over Start Sampling’s web page. However, the argument presented above with respect to the Equinox web page also applies to the Start Sampling web page. The Examiner has acknowledged that the Start Sampling web page fails to limit further use of the purchase procedure by users who have had prior experience with the purchase procedure. This limitation is contained in claims 1 (as a method step) and 9 (as a means element) and in all claims dependent therefrom. Therefore, for the same reasons given above with respect to the Equinox web page,

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the Start Sampling reference has also been overcome as to claims 1 and 9 and those claims dependent from claims 1 or 9.

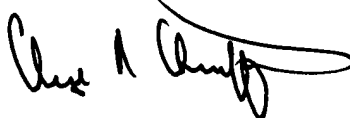
It is noted that, as to claim 9, the Examiner argues the terminal's on/off switch provides a "means for limiting ..." However, since the terminal's on/off switch is operated by the user, the same arguments given above apply.

In view of the foregoing, it is requested that the application be reconsidered, that claims 1-22 and 33 be allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at 703-787-9400 (fax: 703-787-7557; email: clyde@wcc-ip.com) to discuss any other changes deemed necessary in a telephonic or personal interview.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,



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